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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/175,905 10/20/98 HICKS

D SPUR102

EXAMINER

TM02/0717

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BOISE ID 83701-1840

BASHORE, W

ART UNIT

PAPER NUMBER

2176  
DATE MAILED:

07/17/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/175,905

Applicant(s)

HICKS et al.

Examiner  
William L. Bashore

Art Unit  
2176

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Nov 13, 1998

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-288 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-288 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

## Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: ☒ approved ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. This action is responsive to communications: original application filed on 10/20/1998, with a provisional filing date of 10/22/1997.
2. Claims 1-288 are pending in this case. Claims 1, 145 are independent claims.

### *Specification*

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: Automatic Network Device Selection And Document Delivery System.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-144 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (hereinafter Suzuki), U.S. Patent No. 6,213,652 issued April 2001, in view of Goertz et al. (hereinafter Goertz), U.S. Patent No. 6,173,295 issued January 2001.

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**In regard to independent claim 1, Suzuki teaches:**

- a system for delivering documents via a network (Suzuki Abstract, column 10 lines 19-23; compare with claim 1 preamble *"a system for delivering documents across a network which comprises:"*).
- outputting and receiving a data stream in an independent format (PDL) (Suzuki column 3 lines 38-44; compare with claim 1 *"a document generator configured to output a data stream in a device independent format"*, and *"a computer configured to receive the device independent format data stream"*).
- Suzuki does not specifically teach selecting a best output device according to compatible features. However, Goertz teaches a print server whereby a decision is made by said server regarding selection of an appropriate printer able to handle a job request (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claim 1 *"analyze the data stream to determine a best output device by comparing....devices available to the computer"*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Goertz to Suzuki, because of Goertz's taught advantage of printer selection, providing a user of Suzuki a way to incorporate selection of diverse printer types to accommodate specialized document requirements if necessary.
- translating print format data to a device specific format, and transmitting said data to a printer (Suzuki Abstract, column 3 lines 38-44, column 10 lines 38-45; compare with claim 1 *"the computer further being programmed to translate the device....to the best output device"*).

**In regard to dependent claim 2, Suzuki teaches a job scheduling ticket comprising a job name, a client name (user-name), and various document attributes, including document data (Suzuki column 45 lines 5-27; compare with claim 2).**

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**In regard to dependent claims 3-4,** Suzuki does not specifically teach an affinity value for calculating a best output device. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Suzuki and Goertz, because Goertz (as applied to claim 1) teaches appropriate selection from a set of diverse printers in order to process a print job, suggesting a form of comparison/decision making, which incorporates numerical comparison at a coding algorithm level, and providing the advantage of comparing printers to Suzuki (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claims 3-4).

**In regard to dependent claims 5-8,** Suzuki teaches a printer job assigned to each printer (Suzuki column 48 lines 60-67; compare with claims 5-8).

**In regard to dependent claims 9-12,** Suzuki does not specifically teach creation/comparing an affinity value for calculating a best output device. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Suzuki and Goertz, because Goertz (as applied to claim 1) teaches appropriate selection from a set of diverse printers in order to process a print job, suggesting a form of comparison/decision making, which incorporates numerical comparison at a coding algorithm level, and providing the advantage of comparing printers to Suzuki (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claims 9-12).

**In regard to dependent claims 13-24,** Suzuki teaches a printer job assigned to each printer in a multiple printer network (Suzuki column 48 lines 60-67; compare with claims 13-24).

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**In regard to dependent claims 25-36**, Suzuki teaches a job ticket comprising various elements (ie. printer name, output-bin-name) to be transmitted to a printer (Suzuki column 45 lines 5-27; compare with claims 25-36).

**In regard to dependent claims 37-72**, Suzuki teaches a separate system comprising a print processor, a job accepting means, a queuing means, an output means, a converting means, and a conversion control means (Suzuki column 10 lines 19-37; compare with claims 25-72).

**In regard to dependent claims 73-144**, Suzuki teaches a job scheduling ticket comprising a job name, a client name (user-name), and various document attributes (Suzuki column 45 lines 5-27; compare with claims 73-144).

6. **Claims 145-288 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (hereinafter Suzuki), U.S. Patent No. 6,213,652 issued April 2001, in view of Goertz et al. (hereinafter Goertz), U.S. Patent No. 6,173,295 issued January 2001.**

**In regard to independent claim 145**, Suzuki teaches:

- a system for delivering documents via a network (Suzuki Abstract, column 10 lines 19-23; compare with claim 145 preamble "*a system for delivering documents across a network which comprises:*").

- outputting and receiving a data stream format, as well as in an independent format (PDL) (Suzuki column 3 lines 38-44, column 45 lines 1-26; compare with claim 145 "*a document generator configured to*

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*output a data stream in a format selected from the group of formats consisting of a device specific format and a device independent format”, and “a computer configured to receive the data stream”).*

- Suzuki does not specifically teach selecting a best output device according to compatible features. However, Goertz teaches a print server whereby a decision is made by said server regarding selection of an appropriate printer able to handle a job request (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claim 145 “*analyze the data stream to determine a best output device by comparing....devices available to the computer*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Goertz to Suzuki, because of Goertz’s taught advantage of printer selection, providing a user of Suzuki a way to incorporate selection of diverse printer types to accommodate specialized document requirements if necessary.

- translating print format data to a device specific format, and transmitting said data to a printer (Suzuki Abstract, column 3 lines 38-44, column 10 lines 38-45; compare with claim 145 “*the computer further being programmed to translate the data stream....to the best output device*”).

**In regard to dependent claim 146**, Suzuki teaches a job scheduling ticket comprising a job name, a client name (user-name), and various document attributes, including document data (Suzuki column 45 lines 5-27; compare with claim 146).

**In regard to dependent claims 147-148**, Suzuki does not specifically teach an affinity value for calculating a best output device. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Suzuki and Goertz, because Goertz (as applied to claim 145) teaches appropriate selection from a set of diverse printers in order to process a print job, suggesting a form

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of comparison/decision making, which incorporates numerical comparison at a coding algorithm level, and providing the advantage of comparing printers to Suzuki (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claims 147-148).

**In regard to dependent claims 149-152**, Suzuki teaches a printer job assigned to each printer (Suzuki column 48 lines 60-67; compare with claims 149-152).

**In regard to dependent claims 153-156**, Suzuki does not specifically teach creation/comparing an affinity value for calculating a best output device. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Suzuki and Goertz, because Goertz (as applied to claim 1) teaches appropriate selection from a set of diverse printers in order to process a print job, suggesting a form of comparison/decision making, which incorporates numerical comparison at a coding algorithm level, and providing the advantage of comparing printers to Suzuki (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claims 153-156).

**In regard to dependent claims 157-168**, Suzuki teaches a printer job assigned to each printer in a multiple printer network (Suzuki column 48 lines 60-67; compare with claims 157-168).

**In regard to dependent claims 169-180**, Suzuki teaches a job ticket comprising various elements (ie. printer name, output-bin-name) to be transmitted to a printer (Suzuki column 45 lines 5-27; compare with claims 169-180).



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**In regard to dependent claims 181-216** , Suzuki teaches a separate system comprising a print processor, a job accepting means, a queuing means, an output means, a converting means, and a conversion control means (Suzuki column 10 lines 19-37; compare with claims 180-216).

**In regard to dependent claims 217-288**, Suzuki teaches a job scheduling ticket comprising a job name, a client name (user-name), and various document attributes (Suzuki column 45 lines 5-27; compare with claims 217-288).

***Conclusion***

**7. Prior art made of record and not relied upon is considered pertinent to disclosure.**

Gusmano et al.	U.S. Patent No. 6,252,681	issued	June	2001
Guck	U.S. Patent No. 5,911,776	issued	June	1999
Morgan et al.	U.S. Patent No. 5,220,674	issued	June	1993

**8.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is **(703) 308-5807**. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on **(703) 308-5186**. The fax number to this art unit is **(703) 308-6606**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 305-3900**.

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9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

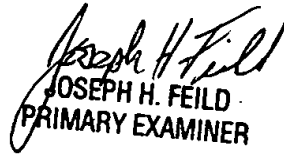
(703) 308-9051, (for formal communications intended for entry)

**or:**

(703) 305-9724 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Fourth Floor (Receptionist).**

William L. Bashore  
7/11/2001

  
JOSEPH H. FEILD  
PRIMARY EXAMINER